

## **REMARKS**

### **History of Prosecution**

The above-captioned application was initially filed with a total of 17 claims including independent claims 1, 2, 7 and 13. All of these claims were rejected in a first Office Action. In response to that first Office Action, several of the claims were amended and new claims 18 and 19 were added to the application.

In the outstanding second Office Action, all of the claims had been rejected under 35 USC 112. In addition, claims 1-13 and 15-19 have been rejected under 35 USC 102 (b), and claim 14 has been rejected under 35 USC 103. In this response to the second Office Action, claims 1-6, 9, 11, 14 and 18-19 have been cancelled from the application. Claims 1-6 have been significantly rewritten and are now presented as new claims 22-27. New claims 20, 21 and 28 have also been added to the application. As presently submitted, the application includes claims 7, 8, 10, 12-13, 15-17 and 20-28. These claims presently submitted include independent claims 7, 13, 20 and 21.

### **Claims Rejected Under 35 USC 112, first paragraph**

This rejection includes claims 1-17 which are rejected as failing to comply with the enablement requirement. It is suggested in the Office Action that the claims define a finished wood slat made from rejoining multiple slats and cutting the rejoined slats along a direction perpendicular to a face plane of the slats such that the "form lines" are exposed and appear to be side-by-side and extend throughout the length. It is further

suggested in the office action that the claims detail that the joining marks are hidden while other claims suggest that the marks are exposed.

The specification of the application focuses on the undesirable zig-zag shape which results from the common practice of forming finger joints to produce wood blocks free of defects such as knot holes. It is this zig-zag shape which is hidden in the slats formed in accordance with the present invention. When a first set of slats are cut from an initial block, each of the slats has a face plane that contains the undesirable zig-zag shape.

As disclosed in the specification, these first slats can then be laminated to form a second block. As illustrated in Figure 9, this second block still shows the undesirable zig-zag shapes on the face planes of the outer slats. However, by making consecutive cuts in this block along planes that are transverse (usually perpendicular) to the face planes of the first slats, the undesirable zig-zag lines disappear and are effectively hidden. These cuts along the planes A-A illustrated in Figure 9 produce the slats of figure 10 which do not contain the undesirable zig-zag shapes.

Claims Rejected Under 35 USC 112, second paragraph

This rejection includes claims 3, 8, 9, 14 and 15 which are said to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is further suggested that claims 3 and 8 are not clear as to how the slats have exposed adjoining lines that are hidden. Claim 3 (as new claim 22) and claim 8 have been significantly amended to clarify this distinction.

Claims 8, 9, 14 and 15 are suggested to be unclear as to how the markings and rectangular shape relate to the new bulk section or the original bulk section. Claims 9 and 14 have been cancelled. Claims 8 and 15 have been amended to further clarify the claims.

Claims Rejected Under 35 USC 102

Claims 1-13 and 15-19 are included in this rejection as being anticipated by US Patent No. 6,763,873 to Lee. Of these claims, claims 1-6 are now presented as new claims 20-25, and claims 9, 11, 18 and 19 have been cancelled from the application.

As evidenced by the title of the Lee patent, his invention relates to an Efficient, Natural Slat System, Covering and Method. Throughout his application Lee discloses wooden slats that are wrapped with pattern paper such as that illustrated in figure 4 and designated by the reference numerals 121 and 123. Another covering and method is disclosed with reference to figure 12. In all cases, the final appearance of the slat is that given by the covering. There is absolutely no interest in the appearance of the underlying wood layer.

Notwithstanding the presence of the covering in Lee's concept, the wood slat itself does not have any relevance to applicant's invention. As illustrated in figures 4, 11, and 12, the slat of Lee is cut from a block such that the zig-zag line (which is undesirable in applicant's invention) appears prominently along the face plane of the slat. This is of no concern to Lee since he teaches how these face planes can be hidden by coverings. The wood slats of Lee appear exactly as Applicant showed in

figure 7 and attributed to the prior art. There is no formation of a second block formed from slats containing the undesirable zig-zag configuration. Nor is there any cutting of slats in a plane that is transverse to the face plane containing the undesirable zig-zag shape.

Lee in fact teaches away from this second cutting of slats as he pursues his interest in stress concentrations. In column 10 line 3-11, Lee fully accepts the finger pattern 109 in his slat 205 as the finger pattern enhances protection against major stress concentrations in the middle of the slat.

With reference to the claims as amended, it will be noted that Lee neither discloses nor contemplates the elements of applicants invention, for example as recited in claim 7. Notably, Lee does not contemplate a step of providing a first bulk section of wood that is cut along first parallel planes in a successive order to form a plurality of first slats each having a face plane. Nor does Lee contemplate joining the face planes of the first slats in an order different then the first order to create a new bulk section in the form of a laminate with parallel adhesion planes. Furthermore, Lee fails to appreciate the advantages achieved by applicant in cutting the new block section along second parallel planes generally transverse to the first parallel planes. These recitations in claim 7 and each of the claims dependent thereon should render these claims allowable.

With reference to claim 13, it will be noted that Lee does not contemplate a wood slat prepared by a process including the steps of cutting successive sections of a bulk section of wood to form a plurality of individual wood pieces, and then rejoining these

wood pieces in a different order to form a new bulk section. With his emphasis on stress concentrations, Lee sees no advantage in cutting the wood slat along second parallel planes transverse to the first parallel planes so that the wood slat has a desirable veneer appearance. Again, Lee covers his wood slats so that the covering provides the only appearance of his ultimate product. These recitations in claim 13 and the claims dependent thereon should render all of these claims allowable.

With respect to claim 22, Lee does not contemplate a slat including first manufactured wood slats each having a face plane and at least one zig-zag joining line exposed on the face plane. Nor does he contemplate laminating these first slats together and slicing the laminate along a direction perpendicular to the face planes of the first manufactured wood slats to produce second manufactured wood slats each having a face plane free of any exposed zig-zag joining lines. These recitations should render claim 22 allowable.

Claim 23 recites a wood slat having a final face defined by periphery edges of a plurality of first slats each having a face plane containing undesirable joining marks. The face planes are recited as being generally transverse to the periphery edges of the first slats so that the undesirable joining marks are not exposed in the finished wood slat. Lee shows no concern for the pattern of the joining marks as he teaches the concept of hiding these marks with a covering. Accordingly, claim 23 and the claims dependent thereon should all be allowable.

Applicant encourages the Examiner to telephone the undersigned attorney if it appears that a telephone conference would facilitate allowance of the application.

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Art Unit 3635

Reply to December 4, 2006 Office Action

Attorney Docket No. C&M1.PAU.19

**Patent Application**



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by Eric Hoover

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